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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,342	01/27/2005	Donald Horton	020512.0005US	5752

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Rutan & Tucker, LLP.
Hani Z. Sayed
611 ANTON BLVD
SUITE 1400
COSTA MESA, CA 92626

EXAMINER	
FISHMAN, MARINA	

ART UNIT	PAPER NUMBER
2832	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/523,342	HORTON ET AL.	
	Examiner	Art Unit	
	Marina Fishman	2832	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 October 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

General status

1. This is a Final Action on the Merits for RCE. Claims 1 - 12 are pending in the case and are being examined.

Claim 11, is identified as "currently amended", this claim is interpreted to be "previously presented" as no amendment was found in the claim.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1 – 8 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 4-5, it is not clear what is meant by "wherein the detent subassembly is enclosed and operates independent of the knob." According to Figure 3, the knob 305 is connected to shaft 365 by screw 307 and the detent subassembly comprises sprocket 326, rotor 324, spring 320, ball 322 and cap 315 (instant specification page 5, second paragraph) and sprocket 326 is held by locking screw 329 against bushing 355; and the rotation of shaft 365 causes rotor 324, spring 320 with associated balls 322 and electrical contacts to rotate (page 5, third paragraph). Thus part of the detent subassembly rotates by rotation of the knob and therefore, the recitation "wherein the detent subassembly is enclosed and operates independent of the knob" is contrary to the disclosure.

Regarding Claim 2, it is not clear, what is meant by "operation of detent subassembly is not altered by the removal of the knob". If the knob is removed, the shaft can not be rotated, and the switch assembly can not be operated. What constitutes 'operation' of detent subassembly?

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1 – 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka et al. [US 4,857,677] in view of Allison et al. [US 3,311,718].

Regarding Claims 1, 5, 6 and 9 - 12, Tanaka et al. disclose a rotary switch mounted above and below a panel, comprising:

- a panel [11];
- a rotary switch [41, 42, 29, 30] mounted below the panel;
- a rotary switch [41, 42, 29, 30] mounted below the panel;
- a circuit board [12] with contacts [switches 41, 42 have contacts];
- a knob [44] that substantially covers the detent sub-assembly, the detent subassembly operates with the knob.

Regarding Claims 1, 5, 6 and 9 - 12, Tanaka et al. disclose the instant claimed invention except for a sealing member disposed between a portion of the switch and

underside of the panel and only a bushing and shaft extends through the panel. Allison et al. disclose a switch assembly, with a seal [17]. The seal will be between a portion of the switch and underside of the panel upon mounting the switch assembly to a panel (panel not shown). Allison et al. also disclose a switch with sliding contacts and only a bushing and shaft [12, 24] extend through the panel. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a seal between the panel and the switch and design the switch so that only a bushing and shaft extends through the panel, in Tanaka et al., as suggested by Allison, in order to prevent dirt entering the switch area below the panel and to simplify the switch design.

Regarding Claim 2, as best understood, the operation of detent sub-assembly is not altered by removal of the knob. Regarding Claims 3 and 12, Tanaka et al. disclose arrangement with a spring [36] and a single ball [37]. Regarding Claim 4, the ball will not extend into the panel. Regarding Claims 7 and 8, Tanaka discloses sprocket [portion of 32] with cylindrical lobes [32b] that cooperates with a spring [36], the shaft [24] and rotor [24a, Allison] to set a switch position; the switch position defines the electrical circuit. Regarding Claim 10, the method steps are disclosed by Tanaka et al.; the user can select circuit by rotating the knob.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated

by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1, 7 and 8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 - 3, 10, 11 and 14 of U.S. Patent No. 7,109,430. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the instant application recite a rotary switch with panel mounting, detent sub-assembly on one side of the panel, switch contacts on the other side of the panel, and the detent subassembly a spring and one ball and rotor cams or lobes, these limitations are substantially the same as that of Claims 1 - 3, 10, 11 and 14 of U.S. Patent No. 7,109,430.

8. Claim1 and 8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 15 – 17 and 23 of copending Application No. 11/485,249. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the instant application recite a rotary switch with panel mounting, detent sub-assembly on one side of the panel, switch contacts on the other side of the panel, and the detent

subassembly a spring and one ball and rotor cams or lobes, these limitations are substantially the same as that of 15 – 17 and 23 of copending Application No. 11/485,249.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

9. Applicant's arguments with respect to claims 1 - 12 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Fishman whose telephone number is 571-272-1991. The examiner can normally be reached on 7-5 M-T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Elvin Enad can be reached on 571-272-1990. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Marina Fishman
November 5, 2007

ELVIN ENAD
SUPERVISORY PATENT EXAMINER
11/05/07